

APR 14 2008

REMARKS

The Office Action dated December 12, 2007 has been received and reviewed. This response, submitted along with a Petition for a One Month Extension of time, is directed to that action.

Claim 1 has been amended and claim 2 has been cancelled. Support for the amendments to claim 1 can be found in claim 2 as originally filed and in paragraphs [0020] and [0046] of the specification. No new matter has been added.

The applicants respectfully request reconsideration based on the foregoing amendments and the following remarks.

Election/Restriction

The applicants hereby reaffirm the election of Group I, claims 1-17 with traverse as made during a telephone conversation with the applicant's attorney on December 4, 2007. Claims 18-19 are withdrawn. The applicants reserve the right to file divisional applications on the withdrawn claims, or rejoin should rejoinder be appropriate.

Priority

The Examiner noted that although the applicants have claimed priority to three filed foreign applications, only GB 0404470.7, filed March 1, 2004 is considered to enable the presently claimed invention. The Examiner further stated that the other applications do not enable the invention for "a number of reasons such as for the concentration of ranges of the various claimed components". The applicants respectfully traverse the Examiner's decision regarding priority. The applicants submit that GB 0324295.5 and GB 0404469.9 are fully enabling. If the Examiner maintains the decision

on priority, the applicants respectfully request that the specific elements of the present invention lacking enablement be noted by line and page number so that the applicants can fully address each point.

Claim Rejections- 35 U.S.C. §112

The Examiner rejected claims 1, 3-14 and 16-17 under 35 U.S.C. §112, second paragraph as indefinite. The applicants have amended claim 1 to incorporate the limitations of originally filed claim 2, thus rendering the present rejection moot.

Claim Rejections- 35 U.S.C. §102/103

The Examiner rejected claims 1, 3-14 and 16-17 under 35 U.S.C. §102(b) as anticipated by Hahn (GB 2,372,500). The applicants submit that the amendment to claim 1 whereby the limitations of originally filed claim 2 were incorporated therein have rendered this rejection moot, and the applicants respectfully request that the Examiner withdraw this rejection.

The Examiner further rejected claims 1-7, 13-14 and 16-17 under 35 U.S.C. §102(e) as anticipated by Izuki et al. (US 2003/0220182 A1), and claims 8-10 under 35 U.S.C. §102(e) or, in the alternative, 35 U.S.C. §103(a). The Examiner stated that Izuki teaches a glass and optical element made of optical glass, which anticipates the claims. Moreover, the Examiner stated that the limitations embodied in claims 8-10 would have been obvious to one of ordinary skill in the art. The applicants respectfully traverse these rejections.

The presently claimed invention now relates to a composition comprising zinc and bismuth, wherein the composition releases zinc and bismuth in an amount sufficient to ensure glassware protection during a dishwashing process. Izuki et al. is directed to an optical glass composition. The optical glass of Izuki fails to teach or even suggest that zinc and bismuth are or can be released from a composition during a dishwashing process. Moreover, there is no reason why the person of ordinary skill in the art would consider using an optical glass to protect glassware in a dishwashing process.

Additionally, the presently claimed mole ratio of zinc to bismuth in the composition supports the distinction between an optical glass of Izuki and the presently claimed invention in that the dissolution of the glassware proceeds cleanly without residue formation when using a composition of the presently claimed invention. Clearly, the clean dissolution of glass is not a consideration for a piece of optical glassware, and the skilled artisan would not look to such a teaching when attempting to solve the problem addressed by the presently claimed invention.

For the reasons stated above, the applicants submit a *prima facie* case of anticipation or obviousness cannot be established over the presently claimed invention in view of Izuki et al., and respectfully request that these rejections be withdrawn.

The Examiner also rejected claims 1-3, 5-14 and 16-17 under 35 U.S.C. §102(e) as anticipated by Ogino et al (US 2004/0018933 A1), and claims 4 and 15 under 35 U.S.C. §103(a) as anticipated by or, in the alternative, obvious over Ogino. The applicants respectfully traverse these rejections.

Like Izuki, Ogino Izuki et al. is directed to an optical glass composition. The optical glass of Ogino fails to teach or even suggest that zinc and bismuth are or can be

released from a composition during a dishwashing process. Moreover, there is no reason why the person of ordinary skill in the art would consider using an optical glass to protect glassware in a dishwashing process.

Additionally, the presently claimed mole ratio of zinc to bismuth in the composition supports the distinction between an optical glass of Ogino and the presently claimed invention in that the dissolution of the glassware proceeds cleanly without residue formation when using a composition of the presently claimed invention. Clearly, the clean dissolution of glass is not a consideration for a piece of optical glassware, and the skilled artisan would not look to such a teaching when attempting to solve the problem addressed by the presently claimed invention.

For the reasons stated above, the applicants submit a *prima facie* case of anticipation or obviousness cannot be established over the presently claimed invention in view of Ogino et al., and respectfully request that these rejections be withdrawn.

The Examiner rejected claims 1-5, 13-14 and 16-17 under 35 U.S.C. §102(e) as anticipated by Kasuga et al. (US 2004/0138043 A1), and claims 6-7, 8-10 and 15 under 35 U.S.C. §102(e) or, in the alternative, 35 U.S.C. §103(a) as obvious over Kasuga. The applicants respectfully traverse these rejections.

At first, the applicants submit that Kasuga is improperly cited as prior art under 35 U.S.C. §102(e) because a priority date of the presently claimed invention, October 17, 2003, precedes the filing date of Kasuga. Accordingly, the applicants respectfully request that these rejections be withdrawn.

In the event that the priority document relied upon to antedate Kasuga is deemed to not enable the presently claimed invention, which the applicants do not concede but

address herein only for the sake of argument, the applicants respectfully submit that Kasuga, like Izuki and Ogino discussed above, is directed to an optical glass. The applicants hereby restate the arguments directed to the optical glass compositions of Izuki and Ogino with respect to Kasuga. Accordingly, even if Kasuga is deemed to be prior art over the presently claimed invention, a *prima facie* case of anticipation or obviousness cannot be established.

#### Double Patenting

The applicants hereby acknowledge the obviousness-type double patenting rejections over the claims in view of copending applications 10/468,669; 10/575,201; and 10/558,211. The applicants respectfully request that the Examiner hold these rejections in abeyance until patentable subject matter is indicated in the presently claimed invention. The applicants will then revisit these rejections and file terminal disclaimers over the copending applications, if appropriate.

The applicants believe the claims are now in condition for allowance, and such favorable action is respectfully requested. If any issues remain, the resolution of which can be advanced through a telephone conference, the Examiner is invited to contact the applicant's attorney at the phone number listed below.

#### CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicant respectfully requests that this be considered a petition therefor. The

Commissioner is authorized to charge any fee(s) due in this connection to Deposit  
Account No. 14-1263.

**ADDITIONAL FEE**

Please charge any insufficiency of fees, or credit any excess, to Deposit Account  
No. 14-1263.

Respectfully submitted,

NORRIS MCLAUGHLIN & MARCUS, P.A.

By M. Marin  
Mark D. Marin  
Attorney for Applicant  
Reg. No. 50,842  
875 Third Avenue, 18<sup>th</sup> Floor  
New York, NY 10022  
Tel. 212-808-0700